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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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JUN 3 0 2003

**In re Application of Atkinson et al****Serial Number      09/826,924****Filed April 6, 2001**

)  
 ) Group Art Unit: 3727  
 )  
 ) Examiner: Ngo  
 )  
 ) Atty. Docket: LED001

**For: Compact Packaging for Garments Made From Delicate Materials**

**APPLICANT'S APPEAL BRIEF**

**Commissioner For Patents  
 PO Box 1450  
 Alexandria, VA 22313-1450**

**Dear Sir:**

**RECEIVED**  
**JUL 03 2003**  
**TECHNOLOGY CENTER R3700**

The applicants of the above-identified U.S. patent application submit this Appeal Brief in support of an appeal from the final rejection of claims 1-13, 15-17, 21-27 and 29 in this application. The fee required under 37 C.F.R. §1.117(f) accompanies this brief.

**REAL PARTY IN INTEREST**

The above-identified patent application has been assigned to LeDagio Ltd. which assignment has been duly executed by each of the inventors. The assignment document was submitted for recordal commensurate with the filing of the application and was recorded on April 6, 2001 on Reel 011686, Frame 0385.

**RELATED APPEALS AND INTERFERENCES**

There does not exist any known related appeals or interferences which would directly affect or be directly affected by or have a bearing on the decision in this case.

**STATUS OF CLAIMS**

The application was originally filed with 43 claims, all of which were subject to a restriction requirement between the compact package of claims 1-29; the method of packing a garment of claims 30-38; and the apparatus for packing a garment of claims 39-43. For prosecution in this case, the Applicant elected the compact package of claims 1-29.

In response to the First Office Action on the merits, claims 1, 15, 16 and 29 were amended, while claims 14, 28 and the non-elected claims 30-43 were canceled. Therefore, claims 1-13, 15-27 and 29 remain in the application as presented on the Appendix of Claims submitted herewith. Of the pending claims, claims 18-20 have been indicated to be dependent on a rejected based claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Therefore, claims 1-13, 15-17, 21-27 and 29 stand rejected and form the basis for this appeal.

**STATUS OF AMENDMENTS**

As indicated above, claims 1, 15, 16 and 29 were amended during the prosecution of this application and claims 14, 28 and 30-43 were canceled. The remaining claims stand as originally filed. There are no outstanding amendments which have not been entered.

**SUMMARY OF THE INVENTION**

The present invention is directed to a compact packaging arrangement for delicate garments and, more particularly, to the compact packaging of hosiery (see specification on page 1, lines 5-7). In connection with packaging hosiery where the hosiery garment is compressed to multiple times its loose density, (see, for example,

page 9, lines 16-24), extreme care must be taken to assure that the actual packaging or container does not damage the hosiery (see page 8, lines 5-7 and page 10, lines 5-7).

As perhaps best shown in Figure 3 and described on page 6, line 16 through page 9, line 3, each garment package 2 includes a container body 6 within which a piece of hosiery 83 is compressed to multiple times its loose density such that a very compact arrangement is presented. In general, the most preferred form of the invention provides for a container body storage volume of less than 10 in<sup>3</sup> (see page 9, lines 4-12). Because of the extreme delicate nature of certain hosiery to be packaged, a buffer material 86, i.e., a light paper material or fabric (page 10, lines 1-5), is placed atop hosiery 83 in at least one embodiment of the invention to protect hosiery 83 from being pinched or otherwise damaged. Thereafter, a cover member 40 is placed within container body 6 (page 10, lines 8-12) to retain hosiery 83 therein. Cover member 40 includes a convex base and a plurality of openings 47 (page 7, lines 9-13) to enhance insertion of cover member 40 and allow air to escape when positioning cover member 40. In addition, cover member 40 is formed with a pivoting, ring-shaped pull-tab 58 having an associated living hinge 60 (page 7, lines 14-20) to allow pull-tab to be lifted as shown in Figure 2 to remove cover member 40 in order to access hosiery 83.

Container body 6 is formed with inwardly extending projections 30-33 (page 7, lines 3-5) beneath which cover member 40 is placed, thereby retaining cover member 40 (page 10, lines 8-12) in a position which maintains hosiery 83 in place (page 9, lines 24-26) until cover member 40 is manually removed. Thereafter, a cap member 65 is snap-fit upon container body 6 (page 10, lines 12-17). To this end, a plurality of projections 72 and 73 (page 7, line 24 through page 8, line 3) engage an annular lip 37 (page 7, lines 6-8) of container body 6. A seal and hanger assembly 90 (page 8, lines 20-26 and page 10, lines 17-19) can be attached for final packaging/display purposes.

**ISSUES**

The issues presented in this appeal is whether or not:

- 1) Claims 1, 9, 11, 12, 15, 16, 25, 26 and 29 are anticipated under 35 U.S.C. § 102(b) by Brecher patent 3,826,359;
- 2) Claims 1, 5-7, 9, 10-13, 15-17, 21-27 and 29 are unpatentable under 35 U.S.C. § 103 over Kirkland patent 6,006,945 in view of O'Leary patent 4,802,577 and further in view of Diaz patent 5,193,163; and
- 3) Claims 1-4 and 8 are unpatentable under 35 U.S.C. § 103 over Curtis patent 6,085,930 in view of "Official Notice."

The Examiner had adopted the positions that: the hosiery packaging device disclosed in the '359 Brecher patent discloses each and every limitation in each of the independent claims of this application, as well as many of the dependent claims; it would be obvious to one of ordinary skill in the art to modify the can-type container of Kirkland to include a buffer material in view of the '577 O'Leary patent and to include a cap in view of the '163 Diaz patent in order to "provide more protection covers for the material stored in the package"; and it would be obvious to modify the container arrangement of the '930 Curtis patent to store hosiery based on "Official Notice."

The applicant disagrees with the Examiner's position for at least the following reasons:

1. The Examiner has not addressed each and every limitation in the claims when applying the prior art;
2. The Examiner has failed to set forth a prima facie case of obviousness by adequately considering the overall invention and the differences between the prior art and the claimed subject matter;
3. The manner in which the Examiner has combined the various references is considered to involve prohibitive hindsight;

4. The Examiner has taken "Official Notice" improperly in rejection certain ones of the claims;
5. The prior art taken singly or in combination simply does not teach the invention and, in fact, it is considered to teach away from the invention; and
6. Significant indicia of non-obviousness exists to rebut the "obviousness" positions taken by the Examiner.

### **GROUPING OF CLAIMS**

Claims 1,2, 3, 4, 6, 8, 9, 10, 11, 12, 16, 17, 22, 24, 25, 26 stand alone;  
claim 5 stands or falls together upon a determination of the patentability of claim 1;  
claim 7 stands or falls together upon a determination of the patentability of claim 6;  
claim 13 stands or falls together upon a determination of the patentability of claim 12;  
claim 15 stands or falls with a determination of the patentability of claim 1;  
claim 21 stands or falls with a determination of the patentability of claim 16;  
claim 23 stands or falls with a determination of the patentability of claim 22;  
claim 27 stands or falls with a determination of the patentability of claim 26;  
and  
claim 29 stands or falls together upon a determination of the patentability of claim 16.

### **ARGUMENTS**

#### **I. Brief Legal Analysis**

In order to anticipate a claimed invention, the prior art must disclose each and every limitation set forth in a claim must be found, either expressly or inherently

described, in a single prior art reference. *Verdegeal Bros, v. Union Oil Co. of California*, 814 F. 2d 628, 2 USPQ 1051 (Fed, Cir. 1987).

The test for patentability under 35 U.S.C. § 103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of ordinary skill in the art must be considered, along with the relevant secondary issues. *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966).

A proper rejection under 35 U.S.C. § 103 cannot be based on hindsight knowledge of the invention under consideration for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 218 USPQ 865, 870 (1983) stated:

*All the pieces of the present invention were known in the art, ... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art (Case citations).*

Further, the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984) stated:

*The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)*

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

*A patentable invention... may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)*

Similarly, the Court of Appeals for the Federal Circuit *In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 5 (1983) stated:

*We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings long the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.*

Finally, the claims of an application in question cannot be used as a blueprint to find prior art. *Interconnect Planning Corp. v. Feil*; 227 PQ 2d 543, 551 (Fed. Cir. 1985).

References must be evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *In re Shuman and Meinhardt*, 150 USPQ 54 (CCPA 1966).

If the modifications are suggested by the Examiner in order to achieve the claimed invention would destroy the fundamental characteristics of the base reference, the rejection is improper. *In re Rosin* 673 F.2d 388, 213 USPQ 247.

During examination, the pending claims must be given their broadest, reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F. 3d 1367, 1372, 54 USPQ 2d 1664, 1667 (Fed. Cir. 2000).

Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to become a knowledge in the art are capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F. 2d 1088, 1091, 165 USPQ 418, 420, (CCPA 1970). It is never appropriate to rely solely upon "common knowledge" in the art without evidentiary support in the record, as a principle evidence upon which a rejection was based. *In re Zurko*, 258 F. 3d 1385, 59 USPQ 2d 1697 (Fed. Cir. 2001).

## II. Broad Overview of Application Filing

The assignee of the present invention obtained rights in U.S. Patent No. 5,692,606 which was made of record in this case. In connection with manufacturing the invention set forth in the '606 Patent, certain improvements were made to the packaging arrangement.

A copy of the '606 patent is enclosed herewith for consideration in connection with the following arguments. The undersigned actually prosecuted the application resulting in the '606 patent. As clearly evident from at least claim 1 of the '606 patent, the prior art failed to disclose a compact hosiery package including a container defining a storage chamber having a predetermined volume and a hosiery item that is compressed within the storage chamber to a density corresponding 2 to 12 times its uncompressed, loose density. It is from this point that the present invention was developed and, as will become more fully evident below, each of the independent claims in the present application is considered to have limitations corresponding to those set forth in claim 1 of the '606 patent plus at least two additional elements. Based on the smooth prosecution and allowance of the '606 patent, it is submitted that

**APPLICANT'S APPEAL BRIEF**

**Serial No. 09/826,9**

**Page 9**

a consistent examination procedure by the U.S. Patent Office would have actually resulted in a first action allowance of the present application.

**III. The rejections of claims 1, 9, 11, 12, 15, 16, 25, 26 and 29 as being anticipated by the '359 Brecher patent**

The present invention is presented in its broadest terms in claims 1 and 16 in this application. For claim 1, the Examiner has rejected the claim three different ways. Certainly, in cases where a sound rejection on the basis of prior art discloses the "heart" of the invention, secondary rejections should ordinarily not be made (see M.P.E.P. § 707.07(g)). Obviously, the Examiner did not feel that any of the prior art discloses the "heart" of the invention such that multiple rejections were presented. In general, this multiple rejection arrangement is seen to highlight the weakness of the position taken by the Examiner since, for instance, if the Examiner truly believed in the §102 anticipatory reference of many of the claims in this case, obviousness-type rejections utilizing multiple references and taking official notice would not have been made. Regardless of the fact that the Applicant has expressed a willingness to work with the Examiner in this case and has taken the time and expense to conduct a personal interview to this end, no agreements could be reached.

In any case, the Examiner holds that claim 1 is anticipated by Brecher patent 3,826,359. First of all, it must be recognized that claim 1 is directed to a compact package having a container. Brecher on the other hand shows a packaging arrangement wherein multiple containers can be stacked one on top of the other. Where claim 1 of the present invention includes a container body, a garment compressed therein to multiple times its loose, uncompressed density, a buffer material that is separate from the garment and arranged upon the garment within a storage chamber of the container, and a cover member extending across the open end of the storage chamber to retain both the garment and the buffer material therein, each container in Brecher only includes a cylindrical body having a bottom and a single top. In an attempt to read the Brecher arrangement on the present invention, the

Examiner is equating the top of the bottom container to the buffer material recited in claim 1 and the bottom of the top container as the recited cover member. It is submitted that this is an unreasonable interpretation of the claim language in light of the invention. That is, in properly considering the invention as a whole, the claimed buffer material does not at all equate to the top of the bottom container in Brecher and it is considered unfair to consider the bottom of the top container as the recited cover member. In accordance with Brecher, the entire top container 10 could be removed and the packaged item will remain in the bottom container. In accordance with the present invention, the cover member actually extends across the open end of the single storage chamber to retain the garment and the buffer material within the container body. You cannot remove the cover member from the compact package of the present invention in any manner analogous to that of removing the top container in the packaging device of Brecher.

In stating that claim 1 is anticipated by Brecher, the Examiners has failed to address the fact that the garment in accordance with the compact package of the present invention must be compressed to multiple times its loose, uncompressed density when placed in the storage chamber of the container body. For the same reason that Brecher does not disclose or render obvious the invention set forth in at least claim 1 of U.S. Patent No. 5,692,606 which requires the compressed density to be within 2-12 times an associated uncompressed, loose density, Brecher does not disclose the compression arrangement of the present invention. Instead, the Brecher arrangement is much larger than that of the present invention. Instead of being "compact" with the garment being heavily compressed therein, there is clearly a significant amount of space between the garment and the container in Brecher. At best, Brecher is seen to disclose an arrangement which would be more analogous to pantyhose packaged under the LEGGS trademark, as opposed to a much more compact package in accordance with the present invention such as marketed under the HEAVEN SENT pantyhose found in many convenience stores, including most 7-Elevens through the country. It is respectfully submitted that nowhere in the Office Action does the Examiner address the specific limitation of the garment being

**APPLICANT'S APPEAL BRIEF**

Serial No. 09/826,9

Page 11

compressed to multiple times its loose uncompressed density. At best, page 2 of the final Office Action mentions that the garment is "compressed". Nowhere in Brecher is it discussed that a garment can be packaged to multiple times its loose uncompressed density such that Brecher simply does not anticipate the subject matter of claim 1.

In addition to these deficiencies, claim 1 requires that the cover member extend across the open end of the storage chamber. Since the top of the lower container in Brecher closes off any open end of the lower container, there is no open end left for even the bottom of the upper container in Brecher to extend across. To say that the bottom of the upper container in Brecher constitutes a cover member for the lower container, the Examiner might as well call the ceiling of a building in which the package of Brecher is in to constitute the cover member. Clearly, this structure finds no correlation to the cover member 40 of the present invention which extends across the open end of container body 6.

Claim 9 further adds the inclusion of cap member 65 upon container body 6. Where the cover member extends across the open end of the container storage chamber, the cap member is mounted over the open end of the container body. The Examiner holds that element 12 in Brecher constitutes the cap member recited in this claim. Not only is element 12 part of an entirely different container, but element 12 actually constitutes a tubular sleeve which itself has open top and bottom portions and therefore cannot extend over an open end of a container body and act as a cap. Again, the relied upon arrangement shown by Brecher simply shows how multiple containers constructed in accordance with Brecher can be stacked one on top of the other. This does not change the fact that they are separate containers that individually hold garments, with each container only including a sleeve 12, a bottom, a top and a garment.

Claim 11 specifically recites that the storage chamber has a total volume less than 10 cubic inches. This limitation is not at all addressed in the final Office Action and it is respectfully submitted that the container of the present invention is multiple times smaller than that disclosed by Brecher.

This volume limitation is specifically brought out in independent claim 16 which requires not only the volume of the container body to be less than 10 cubic inches, but that the garment be compressed therein to multiple times its loose, uncompressed density. As indicated above, neither of these limitations are at all addressed in the final Office Action in connection with the application of the Brecher patent.

Claim 16 differs from independent claim 1 in that claim 16 does not require the inclusion of the buffer material, but does include a limitation directed to the cap member corresponding to that recited in claim 9. Therefore, claim 16 essentially represents a combination of claims 1, 9 and 11, without the limitation concerning the buffer material. It is again respectfully submitted that Brecher has, at best, a top cover which the Examiner has stated to be the buffer material. Regardless, the Brecher reference does not have the compact container configuration of the present invention, a garment compressed therein as required by claim 16, or the combination of both a cover member and cap member as specified. Without addressing each and every one of these limitations, it is respectfully submitted that the Brecher patent cannot properly be used as an anticipatory reference.

Claim 25 reintroduces the buffer material such that this claim requires the combination of the specific volume size, the garment compression, the cover member, the cap member and the buffer material. For the reasons seen to be clearly set forth above, this claim is seen to even further distinguish the present invention from the Brecher arrangement.

With respect to claim 26, there is simply no teaching in Brecher et al. to place a buffer material within the container in a manner analogous to that of the present invention, let alone a buffer material which is different from the delicate material of the garment. Again, as clearly disclosed in the present application, the buffer material can be utilized to protect the delicate garment of the material from being pinched, ripped or the like when the cover member is inserted within the container body. Therefore, the buffer material essentially establishes a buffer zone to protect the garment. None of the prior art, particularly the Brecher reference, discloses any such arrangement.

IV. Rejection of claims 1, 5-7, 9, 10-13, 15-17, 21-27 and 29 based on the combination of Kirkland patent 6,006,945 in view of O'Leary patent 4,802,577 and Diaz patent 5,193,163.

The arrangement disclosed by Kirkland et al. actually reminds the undersigned of containers for tennis or racket balls wherein a container is sealed by means of a metal lid that can be selectively removed. The purpose of the Kirkland arrangement is to provide a container structure which is sized and configured to be vendable from a vending machine configured to dispense canned drinks (see Abstract and Summary of Invention such as in column 2, lines 6-14). To this end, the size of the overall container 12 in connection with Kirkland should be realized to be approximately that of a 12 fluid once beverage can. Starting with this overall picture and realizing that the final Office Action does not at all address Kirkland storing a garment to multiple times its loose, uncompressed density as required by claim 12 or to be limited to a storage chamber volume of less than 10 cubic inches (noting that a typical soda can has a volume greater than three times its size), it should be realized that Kirkland is not at all concerned with a compact package analogous to that of the present invention. It is true that Kirkland does disclose a container 12 having a storage space 22 within which a garment can be stored, while including a cover 14 having a pull-tab 26. However, it is respectfully submitted that the Kirkland arrangement does not

define a compact package corresponding to that of the present invention, nor is it used to store a garment at multiple times its loose, uncompressed density.

As recognized by the Examiner, Kirkland lacks both a buffer material and a cap member corresponding to that claimed. However, the Examiner indicates that it would be obvious to provide a buffer material in Kirkland based on the teachings in the '577 O'Leary patent because the belt storage container in O'Leary provides a circular card 20 used to "support any additional hardware supplied for use with the belts 11. For example, a plurality of V-clips 21 may be provided for use with the belts 11." See column 3, lines 50-54. It is unclear to the Applicant why one of ordinary skill in the art would employ a circular card in the container of Kirkland to apparently support additional hardware associated with a belt. Clearly, circular card 20 in O'Leary has nothing to do with establishing a buffer between a delicate garment and a cover member which is positioned to extend across an open end of a storage chamber containing the delicate garment. Aside from attempting to meet the limitations of the present claims, it is respectfully submitted that there is no reason to modify Kirkland in view of O'Leary in the manner suggested by the Examiner.

In addition, the Examiner further modifies this combination of references in view of Diaz to include a cap. Presumably, the Examiner is referring to lid 22 in Diaz. However, the purpose of lid 22 in Diaz is to provide a reclosable cover for a beverage can such that the can will not leak fluid and to provide a hygienic sterile arrangement. There is simply no reason why one of ordinary skill in the art would consider applying the hygienic seal cover for a beverage container as disclosed by Diaz on the container of Kirkland which, in order to address limitations to the claims, must be packaged with hosiery. Instead, it is respectfully submitted that the overall combination of references has simply been made based on impermissible hindsight utilized the limitations of the claims in question as a blueprint to find and combine prior art. The Examiner indicates that the basis for modifying Kirkland in view of O'Leary to include a buffer and in view of Diaz to include a cap is to "provide more protection covers for the materials stored inside the package." However, the purpose

of the disk 20 in O'Leary or the lid 22 in Diaz are not stated to be for this purpose and respectfully are not analogous to the buffer material 86 or the cap member 65 of the present invention.

In connection with this rejection, it is again submitted that the compressed nature of the garment as specifically required by claims 1 and 16 are not addressed in this overall combination as set forth in the final Office Action. To this end, it is also respectfully submitted that at least the limitations of claim 10 regarding the container body including an outwardly projecting lip and the cap member being formed with a plurality of inner projections that snap-fit to the container body, the volume limitations of claims 11 and 16, and the inside surface projections of the container body which are engaged by the cover member as set forth in claim 24 are not at all addressed in the Office Action such that it is respectfully submitted that a prima facie case of obviousness has not been properly established with respect these claims or the claims that depend therefrom.

V. Rejection of Claims 1-4 and 8 as being unpatentable over Curtis 6,085,930 in view of "Official Notice."

In making this rejection, the Examiner has indicated that Curtis includes all the limitations of these claims, aside from the fact that the package in Curtis does not include a garment or hosiery. However, the Examiner states that it would be obvious to put a garment in the Curtis package and, relies upon, as evidenced in the remarks section on page 5 of the Office Action that "Official notice is taken that it is well known in the art to put a garment or hosiery in a package. It would have been obvious to one skilled in the art to put a garment or hosiery in the Curtis package in order the garment or hosiery to be packed for a purposed use." Again, it is respectfully submitted that the modification being made by the Examiner is only based on a blueprint of the present invention. The Curtis patent is specifically directed to a modified atmospheric package for food (see column 1, lines 9 and 10 and column 3, lines 6-11). The Examiner may be correct that it is known to put garments in

packages, but that does not properly equate to taking Official Notice that it would be obvious to put a garment in the food package disclosed by Curtis. Therefore, it is respectfully submitted that the Examiner has taken "Official Notice" improperly in rejecting these claims.

Furthermore, the Curtis package, even as modified by the Examiner, lacks many of the specifics set forth in these claims. Again, independent claim 1 requires that a garment be compressed within the storage chamber of the container body to multiple times its loose, uncompressed density. Curtis shows a very large container. Even if one was to put a garment in any type of similar container, there is absolutely no teaching to compress the garment therein to multiple times its loose, uncompressed density as required by independent claim 1. In addition, it is respectfully submitted that membrane 12 does not equate to the recited buffer material in that the buffer material must be arranged upon the garment. Membrane 12 is heat sealed about the package as disclosed in column 4, lines 30-34. Therefore, membrane 12 is not in the package but extends across the front opening and is not arranged upon a garment. In addition, lid 14 is not seen to extend across an open end of a storage chamber to retain both a garment and a buffer material within the container body in a manner analogous to that required by claim 1.

Claim 3 requires that the body portion of the cover member include an arcuate base, while claim 4 specifies that the lower side of the base is convex in shape. Looking at the cover 14 in Figures 4 and 5 of Curtis would appear to indicate that the cover is substantially planar such that the Applicant can find no arcuate base or convex shape, contrary to that stated in the final Office Action. Finally, with respect to claim 8, it should be noted that the plurality of projections must be provided on the upper inside surface portion of the container body to be engaged by the cover member. Again, the cover member of the present invention is arranged inside the container body such that lid 14 is, at best, more analogous to the cap member of the present invention. This inclusion of a plurality of projections in this specific location has simply not been addressed in the Office Action.

**VI. Further Claim Discussions**

As indicated above, each of claims 1-5, 8-12, 16-21 and 24-26 are considered to stand alone for patentability purposes. The majority of these claims have been addressed above. However, a few additional comments concerning the other claims in the application will be briefly discussed here. Claim 2 covers the subject matter of the cover member including a body portion provided with a plurality of openings. These openings are provided to enable air to escape when inserting the cover member in the storage chamber to maintain the garment therein. This subject matter corresponds to that of claim 18. However, where claim 18 depends from claim 16 and has been indicated to contain allowable subject matter, claim 2 has been rejected based on the teachings in the '930 Curtis patent. It is respectfully submitted that, when the subject matter of claim 2 is not read in a vacuum but in light of the specification, there is absolutely no openings in a cover member in any of the prior art for a purpose analogous to that of the present invention. Particularly, there is no cover member inserted across an open end of a storage container to retain a garment in a container body, while the cover member includes a plurality of openings as set forth in claim 2. The shape of the body portion of the cover member versus the applied prior art has been discussed thoroughly above such that the subject matter of claims 3 and 4 will not be reconsidered here. For claim 6, wherein the '945 Kirkland patent is considered to have a pull-tab, the pull-tab in Kirkland is, at best, bent such as to not specifically have a pivotal connection to the body portion. That is, the pull-tab is rotatably attached through a rivet or the like but is not pivotal in a manner analogous to that of the present invention. Instead, as clearly shown in Figures 2 and 3, pull-tab element 58 has an associated living hinge 60 which enables pull-tab element to be shifted out of the storage chamber when it is desired to remove cover member from within the container body. No such corresponding pivotal arrangement is provided in accordance with the '945 Kirkland patent.

Claim 10 adds particular limitations directed to the manner in which the cap member is mounted over the open end of the container body. That is, the container body is formed, about at least a portion of the open end, with an outwardly projecting lip 37 and the cap member 65 is formed with a plurality of inner projections 72 and 73 such that the cap member can be snap-fit onto the container body with the plurality of inner projections extending about the lip. Simply stated, none of the prior art discloses such a particular cap mounting arrangement for an analogous container body. Claim 17 includes corresponding limitations to that discussed directly above with respect to claim 10, while claim 17 is dependent upon independent claim 16. For at least corresponding reasons, claim 17 is seen to further distinguish the invention over the known prior art. With respect to claims 22, 24, 25 and 26, these claims are seen to further distinguish the present invention from the known prior art for reasons corresponding to those outlined above. For instance, claim 22 includes limitations directed to the pivotally connected pull-tab element in a manner directly corresponding to that of claim 6. Again, the '945 Kirkland patent is the only cited reference to this feature of the invention. In addition, claim 24 includes limitations directly corresponding to those discussed with respect to claim 8. Simply stated, the manner in which the prior art has been applied against this claim has not been discussed in the Office Action with respect to the plurality of projections on an upper inside surface portion of the container body that are engaged by a cover member. The distinctions concerning the buffer material of claims 25 and 26 have been addressed above.

## VII. Additional Comments

It is realized by the Applicants that there is a fair amount of prior art on packaging containers. In fact, the Background of the Invention discusses numerous types of containers, including U.S. Patent No. 5,692,606. However, the assignee has again taken a license under the '606 patent and found the present invention's improvements thereover. As indicated above, the compact hosiery packaging of the present invention has, to date, experienced significant commercial success in the

convenience store and hotel markets. For instance, the majority of the 7-Eleven stores across the United States sell pantyhose utilizing this packaging and the same can be found in other environments, including hotels in Walt Disney World. The present application was drafted utilizing the arrangement in the licensed '606 patent as a starting point and added at least two additional structural elements in each of the independent claims, i.e., the inclusion of the buffer layer and the cover membrane for independent claim 1 and the inclusion of the cover member and cap member in accordance with claim 16. As none of the prior art is seen to disclose or suggest the invention the '606 patent, it is submitted that the present invention is also not anticipated or rendered obvious by the same prior art.

In prosecuting this application, the Applicant did not traverse the multiple restriction requirement set forth by the Examiner. However, it is considered quite interesting that at least independent method claim 30 sets forth corresponding method limitations considered directly analogous to the product limitations set forth in claim 16. That is, claim 30 is directed to a method of packaging a garment made from a delicate material that requires loading the garment within a container having a total volume of less than 10 cubic inches, with the garment being compressed to multiple times a loose, uncompressed density; covering the garment with a cover member to retain the garment within the container body; and engaging a cap member at an open end of the container body across the cover member. This claim was examined in the U.S.P.T.O. in connection with the international application filed in the U.S. Patent and Trademark Office. It is considered quite interesting that no prior art was applied against the method claims or the apparatus for packaging the garment for that matter. That is, all of claims 30-43 were indicated to have a positive opinion with respect to inventive step, novelty and industrial applicability. However, it is questioned how claim 16 can be considered unpatentable based on various different prior art arrangements and yet the corresponding method claim, which is seen to broadly set forth the method to produce the product of claim 16, is clearly considered to be quite distinct in connection with the same prior art applied thereto. It is actually considered that a restriction should not have been originally presented between the product and

**APPLICANT'S APPEAL BRIEF**

**Serial No. 09/826,9**

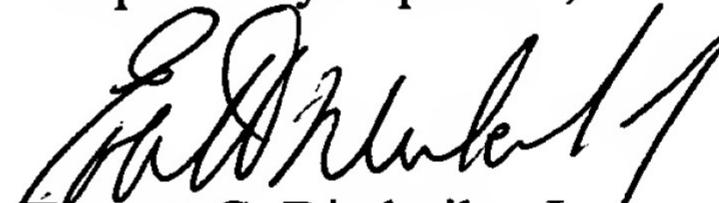
**Page 20**

method as the product of claim 16 would have to be packaged in accordance with the method of claim 30 and that all of these claims should have been considered equally allowable.

**VIII. Summary**

It is respectfully submitted that the Examiner has failed to properly address each limitation in connection with the anticipatory rejection or to establish obviousness under 35 U.S.C. §103 in rejecting the remaining claims in this application. Simply stated, none of the prior art teaches or suggests the invention sought to be patented. For this reason, reversal of the rejections presented in this case, and allowance of all of the claims is respectfully requested.

Respectfully requested,



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**APPENDIX OF CLAIMS**

1. A compact package for a garment made from a delicate material comprising:  
a container body defining a storage chamber having an open end;  
a garment made from a delicate material having an associated uncompressed, loose density, said garment being compressed within the storage chamber of said container body to multiple times the loose, uncompressed density, wherein the garment constitutes hosiery;  
a buffer material, separate from the garment, arranged upon the garment within the storage chamber; and  
a cover member extending across the open end of the storage chamber to retain the garment and buffer material within the container body.
2. The compact package according to claim 1, wherein the cover member includes a body portion provided with a plurality of openings.
3. The compact package according to claim 2, wherein the body portion of the cover member includes an arcuate base.
4. The compact package according to claim 3, wherein a lower side of the base is convex in shape.
5. The compact package according to claim 1, further comprising: a pull-tab element, attached to the body portion of the cover member, for use in removing the cover member from the storage chamber.
6. The compact package according to claim 5, wherein the pull-tab element is pivotally connected to the body portion.
7. The compact package according to claim 6, wherein the pull-tab element constitutes a ring.

8. The compact package according to claim 1, further comprising: a plurality of projections provided on an upper inside surface portion of the container body, said cover member engaging the plurality of projections within the storage chamber.
9. The compact package according to claim 1, further comprising: a cap member mounted over the open end of the container body.
- A 10. The compact package according to claim 9, wherein the container body is formed, about at least a portion of the open end, with an outwardly projecting lip, and said cap member is formed with a plurality of inner projections, wherein said cap member is snap-fit to the container body with the plurality of inner projections extending about the lip.
11. The compact package according to claim 1, wherein the storage chamber has a total volume of less than 10 in<sup>3</sup> (164 cm<sup>3</sup>).
12. The compact package according to claim 1, wherein the buffer material is different from the delicate material of the garment.
13. The compact package according to claim 12, wherein the buffer material is constituted by paper.
14. canceled
15. The compact package according to claim 11, wherein the hosiery constitutes a pair of pantyhose.
16. A compact package for a garment made from a delicate material comprising:  
a container body defining a storage chamber having an open end, said storage chamber having a total volume of less than 10 in<sup>3</sup> (164 cm<sup>3</sup>);  
a garment made from a delicate material having an associated uncompressed, loose density, said garment being compressed within the storage chamber of said

container body to multiple times the loose, uncompressed density, wherein the garment constitutes hosiery;

a cover member extending across the open end of the storage chamber to retain the garment within the container body; and

a cap member mounted to the open end of the container body over the cover member.

17. The compact package according to claim 16, wherein the container body is formed, about at least a portion of the open end, with an outwardly projecting lip, and said cap member is formed with a plurality of inner projections, wherein said cap member is snap-fit to the container body with the plurality of inner projections extending about the lip.

18. The compact package according to claim 16, wherein the cover member includes a body portion provided with a plurality of openings.

19. The compact package according to claim 18, wherein the body portion of the cover member includes an arcuate base.

20. The compact package according to claim 19, wherein a lower side of the base is convex in shape.

21. The compact package according to claim 16, further comprising: a pull-tab element, attached to the body portion of the cover member, for use in removing the cover member from the storage chamber.

22. The compact package according to claim 21, wherein the pull-tab element is pivotally connected to the body portion.

23. The compact package according to claim 22, wherein the pull-tab element constitutes a ring.

24. The compact package according to claim 16, further comprising: a plurality of projections provided on an upper inside surface portion of the container body, said cover member engaging the plurality of projections within the storage chamber.
25. The compact package according to claim 16, further comprising: a buffer material arranged upon the garment within the storage chamber.
26. The compact package according to claim 25, wherein the buffer material is different from the delicate material of the garment.
27. The compact package according to claim 26, wherein the buffer material is constituted by paper.
28. canceled
29. The compact package according to claim 16, wherein the hosiery constitutes a pair of pantyhose.